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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of George Mockry et al

Serial No. 09/878,860

Group Art Unit 3711

Filed May 10, 2002

For: Method of Recording and Playing Baseball Game Showing Each Batter's Last Pitch

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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Name of Applicant, Assignee or Registered Representative

Signature

Date

Kenton L. Freudenberg
16 August 2006

APPEAL BRIEF

1. Real party in interest.

This appeal is brought by the applicants in the above identified application:

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2. Status of claims.

Claims 23-40 are pending. All claims presently stand rejected.

3. Status of amendments.

No amendments have been filed subsequent to final rejection.

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4. Summary of claimed subject matter.

The essential subject matter claimed is a method of editing a recorded baseball game to provide a shortened game for viewing, the method comprising the retention of only the last pitch to each batter for each "at bat." Paragraph 4 of the published application (Publication # 20030060311) summarizes the novel concept as follows .

[0004] In accordance with an aspect of this invention, a film or video record is made of each player's turn at bat. The video record, which can be film, digital, or tape, is edited down to retain the last pitch thrown to each player, plus any resulting action for that pitch. This would record each safe base hit, each walk, strike out, sacrifice fly, ground out, etc. Of course, fielding would be recorded, i.e., each put-out, error, double-play, and throw-out. The resulting video record would be about 10 to 15 minutes, showing all the action of the game. Base running activity (i.e., activity that can also result in either an out or advancement of the runner) can also be retained, such as stolen bases and attempted steals, pickoffs, rundowns, balks, and wild pitches. Some additional material (e.g., narrative) can be included to explain pitching changes, pinch runners, and other substitutions that may affect play.

Claim 23 is directed to a creating video presentation according to the basic method.

Claim 24 is directed to a providing a subscription service using recordings prepared in accordance with the basic method.

Claim 35 is directed to a providing a broadcast for a fee of a recording prepared in accordance with the basic method.

Claim 38 is directed to a providing a subscription for a fee of a recording prepared in accordance with the basic method.

5. Grounds of rejection to be reviewed on appeal.

Claims 23-25,28-30,33-35, 37, 38 and 40 are rejected under 35 U.S.C. 102(b) as anticipated by or in the alternative under 35 U.S.C. §103 as obvious over "ProQuest Producing Sports Channel."

Claims 27,32,36 and 39 are rejected under 35 U.S.C. 103 as obvious over "ProQuest Producing Sports Channel" and further in view of "MediaChannel."

ARGUMENT

6. Rejection of all claims is based in whole or in part upon the "ProQuest Producing Sports Channel" reference ("ProQuest"). At the root of this appeal is the examiner's improper conclusory assumption (See In re Kahn, 441 F.3d 977, 78 U.S.P.Q.2d 1329 (Fed. Cir. 2006)) that the present invention as claimed is nothing more than an edited baseball game. To the contrary, the present invention is directed toward the issue that a full baseball game takes a long period of time to complete. That issue is addressed by providing specific and consistent method or algorithm which can be applied to the editing of a baseball game to achieve the benefit of allowing essentially all the action of a game to be viewed in a much shorter period of time. The essence of that method, as described and claimed, is in its simplest terms, to show the last pitch to each batter. In other words, every batter is shown for every at "bat ," but only one pitch to each batter is retained in the edited game, namely the last pitch to each such batter. While the concept is ultimately relatively simple, there is no suggestion in any of the prior art of record of the use of such a method.

"It does not matter, however, what motivated an inventor to discover the claimed subject matter. The discovery may be by design, by accident, by a vision in a dream, by a sudden flash of genius, or by any other conceivable means. "Patentability shall not be negated by the manner in which the invention was made." 35 U.S.C. § 103 (1988). The relevant consideration is the problem the patent applicant purports to have solved, regardless of the technique employed to achieve that solution." Oscar Mayer Foods Corp. v. ConAgra, Inc., 45 F.3d 443 (Fed. Cir. 1994)

7. The Examiner argues (page 3) that "no criticality is seen in the duration of the edited recording." The examiner ignores that the nature of the invention is to condense the essential action of an entire baseball game into the described period of time. The examiner has cited no prior art which suggests the method claimed by the applicant in the present case. The examiner has also erroneously concluded that showing highlights of a game is equivalent to showing essentially the entire game in a condensed format.

8. The examiner accurately states (page 2) that "ProQuest discloses an edited recording." However, that is all that is disclosed in the ProQuest reference. There is no suggestion that ProQuest describes any method of editing a baseball game or that ProQuest suggests any means by which essentially all of the action of a game can be condensed into a time frame such as that described for the present invention. At best the description in the Proquest reference suggests only an edited game lasting one hour, or 2 to 3 times the length of a game edited according to the present invention.

9. The examiner argues (page2) that "it would have been obvious to one of ordinary skill in the art at the time of the invention to have edited the video to reflect what the editor wished to record based on personal preferences and time available." The examiner provides no support whatsoever to establish that such "personal preferences" would be known to include "only the last pitch to each batter" or that such an editing process could achieve the results of the applicant's invention. The examiner has not met his burden "[t]o reject claims in an application under section 103, an examiner must show an un rebutted prima facie case of obviousness" In re Kahn, supra.

10. In his office action of June 28, 2005 the examiner ignores secondary evidence of non-obviousness by stating (page 9):

"With regard to the statement that 'even the MLB' declares that this is a revolutionary new process: use of hyperbole is well-known in the advertising art. The mere comment made an advertising promotion does not inherently created factual statement."

Whether an advertising statement made by MLB is hyperbole or not is irrelevant, but in any case the examiner is in no position to make such conclusion. What is relevant and undeniable is the fact that MLB is using the method of the present invention and that use is an indicator of "commercial success" appropriately taken into account as a secondary factor of non-obviousness under the standards of Graham v. John Deere Co., 383 U.S. 1, 13-14 (1966).

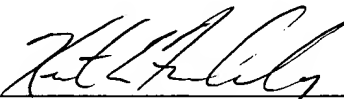
11. As the Court of Appeals for the Federal Circuit has succinctly stated:

... the rule is that the burden of persuasion is on the PTO to show why the

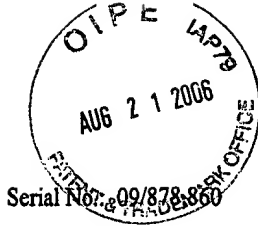
applicant is not entitled to a patent. In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992) (Plager, J., Concurring); *In re Warner*, 54 C.C.P.A. 1628, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967), cert denied, 389 U.S. 1057, 19 L. Ed. 2d 857, 88 S. Ct. 811 (1968); see also *In re Caveney*, 761 F.2d 671, 674, 226 USPQ 1, 3 (Fed. Cir. 1985) ("Preponderance of the evidence is the standard that must be met by the PTO in making rejections.") *In re Epstein*, 32 F.3d 1559 (Fed. Cir. 08/17/1994)

As set forth above the examiner has not provided any prior art sufficient to meet this burden. Accordingly, the applicants herein are entitled to have a patent granted.

Respectfully submitted this 16th day of August, 2006.



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This listing of claims replaces all prior versions and listings, of claims in the application

Claims 1-22 (cancelled)

Claim 23 (Previously Presented). A method of replaying or rebroadcasting a baseball game for which a video recording of the baseball game was produced containing substantially every pitch thrown to every batter from a first pitch to a final pitch and game action resulting from every pitch, together with other action occurring during each appearance by every batter, the method comprising (a) editing the video recording to produce an edited recording, the edited recording having video consisting essentially of (i) the final pitch thrown to every batter and any game action resulting from the final pitch, (ii) successful attempts of runners on base to advance to another base not associated with the game action resulting from the final pitch and (iii) unsuccessful attempts of the runners on base to advance to another base resulting in an out not associated with the game action resulting from the final pitch; (b) obtaining subscribers for viewing the edited recording and (c) playing or broadcasting the edited recording for viewing by the subscribers.

Claim 24 (Previously Presented). A method of providing a subscription for viewing a recorded baseball game in which players from each team appear at bat, and attempt to place a pitched baseball into play and to reach base safely; with players failing to reach base safely being out and players on base attempting unsuccessfully to advance to another base being out; the method comprising: (1) recording each appearance-at-bat for every player and game action resulting from an appearance-at-bat to produce a game recording; (2) editing the game recording of each appearance-at-bat to produce an edited recording by deleting substantially all game action other than (i) game action from a final pitch thrown to each player, (ii) successful attempts of runners on base to advance to another base not associated with the game action resulting from the final pitch and (iii) unsuccessful attempts of the runners on base to advance to another base resulting

in an out not associated with the game action resulting from the final pitch; (3) obtaining subscribers for viewing the edited recording and (4) playing or broadcasting the edited recording as a condensed recorded game for viewing by the subscribers.

Claim 25 (Previously Presented) The method of claim 23 wherein the edited recording for a nine-inning baseball game is about 15 minutes.

Claim 26. (Canceled)

Claim 27. (Previously Presented) The method of claim 23 wherein said step of playing or broadcasting the edited recording for viewing is conducted over the Internet.

Claim 28. (Previously Presented) The method of claim 23 wherein said step of playing or broadcasting the edited recording for viewing is conducted by playing a videotape recording.

Claim 29. (Previously Presented) The method of claim 23 wherein the edited recording contains audio explaining any substitution of players.

Claim 30 (Previously Presented) The method of claim 24 wherein the edited recording for a nine-inning baseball game is about 15 minutes.

Claim 31. (Canceled)

Claim 32. (Previously Presented) The method of claim 24 wherein said step of playing or broadcasting the edited recording for viewing is conducted over the Internet.

Claim 33. (Previously Presented) The method of claim 24 wherein said step of playing or

broadcasting the edited recording for viewing is conducted by playing a videotape recording.

Claim 34. (Previously Presented) The method of claim 24 wherein the edited recording contains audio explaining any substitution of players.

Claim 35 (Previously Presented). A method of obtaining revenue by replaying or rebroadcasting a condensed baseball game, for which a video recording of the baseball game was produced containing substantially every pitch thrown to every batter from a first pitch to a final pitch and game action resulting from every pitch, together with other action occurring during each appearance by every batter, the method comprising (a) editing the video recording to produce an edited recording, the edited recording having video consisting essentially of (i) the final pitch thrown to every batter and any game action resulting from the final pitch, (ii) successful attempts of runners on base to advance to another base not associated with the game action resulting from the final pitch and (iii) unsuccessful attempts of the runners on base to advance to another base resulting in an out not associated with the game action resulting from the final pitch; (b) offering the edited recording to potential subscribers for viewing and (c) playing or broadcasting the edited recording for viewing by the subscribers for monetary consideration.

Claim 36. (Previously Presented) The method of claim 35 wherein said step of playing or broadcasting the edited recording for viewing is conducted over the Internet.

Claim 37. (Previously Presented) The method of claim 35 wherein the edited recording

contains audio explaining any substitution of players.

Claim 38 (Previously Presented). A method of obtaining revenue from editing a recorded baseball game in which players from each team appear at bat, and attempt to place a pitched baseball into play and to reach base safely; with players failing to reach base safely being out and players on base attempting unsuccessfully to advance to another base being out; the method comprising: (1) recording each appearance-at-bat for every player and game action resulting from an appearance-at-bat to produce a game recording; (2) editing the game recording of each appearance-at-bat to produce an edited recording which consists essentially of (i) game action from a final pitch thrown to each player, (ii) successful attempts of runners on base to advance to another base not associated with the game action resulting from the final pitch and (iii) unsuccessful attempts of the runners on base to advance to another base resulting in an out not associated with the game action resulting from the final pitch; (3) offering the edited recording to potential subscribers for viewing and (4) playing or broadcasting the edited recording for viewing by the subscribers for monetary consideration.

Claim 39. (Previously Presented) The method of claim 38 wherein said step of playing or broadcasting the edited recording for viewing is conducted over the Internet.

Claim 40. (Previously Presented) The method of claim 38 wherein the edited recording contains audio explaining any substitution of players.